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REMARKS

This is a full and timely response to the outstanding Office action mailed February 9, 2006. Upon entry of the amendments in this response claims 1-9 and 20-30 are pending. More specifically, claim 30 is added and claim 16 is canceled. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1-3, 5-9, 16, 21, 22, 23, and 25-28 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz, et al* (U.S. Patent No. 6,161,130) in view of *Bates, et al* (U.S. Patent No. 6,785,732). Claims 4, 20, 24, and 29 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz et al* (U.S. Patent No. 6,161,130) in view of *Bates et al* (U.S. Patent No. 6,785,732) and further in view of *Shaw et al* (U.S. Patent No. 6,516,341). These rejections are respectfully traversed.

II. Claim 30 is Clearly Allowable

Applicant first contends that no reference or combination thereof discloses or suggests claim 30 and, therefore, claim 30 is clearly allowable. Applicant respectfully submits that because of the uniqueness of the claim limitations, and especially those added through the foregoing amendment, claim 30 is clearly allowable over all prior references. Among others, the claim element, *the email message having had all attachments automatically unconditionally deleted such that the email message is text only*, is not taught, disclosed, or suggested in the references of record. It is respectfully requested that serious consideration be given to allowing claim 30.

III. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Sall spent with Applicant's representative Benjie Balser during an April 18, 2006 telephone discussion regarding the above-identified Office Action. Applicant believes that various features described in the patent application and recited in the independent claims, including

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unconditionally deleting all attachments and *Bates*, were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Sall seemed to indicate that it would be potentially beneficial for Applicant to file this response.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 1-9, 16, and 20

Claims 1-3, 5-9, and 16 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz, et al* (U.S. Patent No. 6,161,130) in view of *Bates, et al* (U.S. Patent No. 6,785,732). Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz* and *Bates* in view of *Shaw et al* (U.S. Patent No. 6,516,341). For the reasons set forth below, Applicants respectfully traverse the rejection.

Independent claim 1 recites:

1. A method of manipulating email messages with an email network appliance comprising:

receiving an email message, the email message having had all attachments automatically unconditionally deleted such that the email message is text only;

classifying the text only email message;

inserting the text only email message into a classification container; and

presenting the classification container in a classification display section.

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully submit that independent claim 1 as amended is allowable for at least the reason that the combination of *Horvitz* and *Bates* does not disclose, teach, or suggest at

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least receiving an email message, the email message having had all attachments automatically unconditionally deleted such that the email message is text only.

The Office Action alleges that "Bates discloses receiving an e-mail message with attachment, and the attachment is deleted, and the e-mail message without the attachment is sent to the web client." See Office Action, page 4. However, in *Bates*, a virus check is performed and an attachment is removed from the e-mail only under the condition that a virus is detected. In the system of *Bates*, if a virus is not detected, the attachment is not deleted; instead, the attachment is sent with the email to a web client. *Bates* does not disclose having had all attachments automatically unconditionally deleted. In *Bates*, there are conditions under which an attachment is not deleted. *Horvitz* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited references of record, dependent claims 2-9, 16, and 20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-9, 16, and 20 contain all the steps of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2-9, 16, and 20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-9, 16, and 20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 2-9, 16 and 20 are allowable.

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attachments deleted. In *Bates*, there are conditions under which an attachment is not deleted.

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Additionally, with regard to the rejection of claims 1-9, 16, and 20, *Shaw* does not make up for the deficiencies of *Horvitz* and *Bates* noted above. Therefore, claims 1-9, 16, and 20 are considered patentable over any combination of these documents.

B. Claims 1-9, 16, and 20

Claims 21, 22, 23, and 25-28 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz, et al* (U.S. Patent No. 6,161,130) in view of *Bates, et al* (U.S. Patent No. 6,785,732). Claims 24, and 29 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Horvitz et al* (U.S. Patent No. 6,161,130) in view of *Bates et al* (U.S. Patent No. 6,785,732) and further in view of *Shaw et al* (U.S. Patent No. 6,516,341). For the reasons set forth below, Applicants respectfully traverse the rejection.

Independent claim 21 recites:

1. A system of manipulating email messages:

a server configured for receiving a plurality of email messages for a user, and for ***deleting all attachments for all email messages received for a user***; and
a transmitter for transmitting the emails to a user.

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all steps of the claim at issue. Applicants respectfully submit that independent claim 1 as amended is allowable for at least the reason that the combination of *Horvitz* and *Bates* does not disclose, teach, or suggest at least **deleting all attachments for all email messages received for a user**.

The Office Action alleges that “*Bates* discloses receiving an e-mail message with attachment, and the attachment is deleted, and the e-mail message without the attachment is sent to the web client.” See Office Action, page 4. However, in *Bates*, a virus check is performed and an attachment is removed from the e-mail only under the condition that a virus is detected. In the system of *Bates*, if a virus is not detected, the attachment is not deleted; instead, the attachment is sent with the email to a web client. *Bates* does not disclose having had all

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-9 and 20-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

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attachments deleted. In *Bates*, there are conditions under which an attachment is not deleted. Neither *Horvitz* nor *Shaw* cures this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited references of record, dependent claims 22-29 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-29 contain all the steps of independent claim 1. Therefore, the rejection to claims 22-29 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-29 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 22-29 are allowable.

Additionally, with regard to the rejection of claims 21-29, *Shaw* does not make up for the deficiencies of *Horvitz* and *Bates* noted above. Therefore, claims 21-29 are considered patentable over any combination of these documents.

V. Miscellaneous Issues

Applicant respectfully submits that newly added claim 30 is allowable as it claims subject matter not taught, disclosed, or suggested in the references of record. Namely, the claim element, ***the email message having had all attachments automatically unconditionally deleted such that the email message is text only*** is not taught, disclosed, or suggested in the references of record.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-9 and 20-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courtcously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

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